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In re Application of	:	
GRIMM et al.	:	
U.S. Application No.: 10/089,032	:	DECISION ON PETITION
PCT No.: PCT/EP00/09528	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 28 September 2000	:	
Priority Date: 28 September 1999	:	
Attorney Docket No.: 60130-1370	:	
For: VEHICLE DOOR	:	

This is a decision on applicants' "PETITION UNDER 37 CFR 1.47(a)" filed 26 August 2002 to accept the application without the signature of joint-inventor, Gregory Keyes. The required petition fee of \$130.00 (37 CFR 1.17(h)) has been submitted.

### **BACKGROUND**

On 28 September 2000, applicants filed international application no. PCT/EP00/09528 which claimed a priority date of 28 September 1999 and which designated the United States. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 28 March 2002.

On 26 March 2002, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); preliminary amendment; and an information disclosure statement.

On 20 June 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 26 August 2002, applicants filed a Petition under 37 CFR 1.47(a) and the requisite fee and a declaration and power of attorney signed by ten of the eleven joint inventors.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or

cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (3) have been satisfied.

As to item (2), petitioner states that Gregory Keyes cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. It is important that the statement contain facts as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition reveals that petitioner has not satisfied item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Gregory Keyes. Does "application" mean a complete copy of the application was mailed to the nonsigning inventor? Additionally, petitioner alleges that inventor Gregory Keyes cannot be found or located. Petitioner states that "Konig also sent [sic] a copy of the application to Mr. Keyes at his last known address on August 16, 2002 via registered letter. To this date, Mr. Keyes has not responded, and Konig has not been able locate Mr. Keyes." The registered mail letter, provided by the petitioner, is unclear as to the delivery status of the letter. Was the registered letter(s) returned as undeliverable? Was the letter(s) received by Mr. Keyes or by someone at the last known address? Furthermore, it does not appear that the petitioner has first hand knowledge of all the facts.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Gregory Keyes, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

As to Item (4), a review of the declaration filed on 26 August 2002 reveals that declaration is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The declaration filed with the petition includes multiple duplicate sheets. It is unclear if the inventors were presented with only their signature page, in which case the execution would be improper, or if they were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document filed 26 August 2002, which is improper. (See MPEP 201.03, Page 200-7)

For the reasons stated above, it would not be appropriate to accept the application without the signature of Gregory Keyes under 37 CFR 1.47(a) at this time.

### CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.

A handwritten signature in black ink, appearing to read "Anthony Smith", with a stylized flourish at the end.

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